

REMARKS

Claims 6-12 are pending in the application.

Claims 6-12 stand rejected under §103(a) as being unpatentable over Kahle (US 5,518,325). Applicant respectfully traverses the rejection.

Claim 6 distinguishes Kahle '325 by reciting a step of "manually pressing said label onto said compact disk with use of a base plate and a pestle." The Office finds that Kahle lacks the base plate and pestle for use as claimed, but this would be an obvious matter of design choice since the Applicant has not disclosed that this solves any stated problem or is used for any particular purpose. We respectfully disagree because the Abstract and paragraph 13 of the published application show that the system as described aligns the sticker on the disk. See also paragraph 31. Kahle '325 is silent as to this need and does not even recognize the problem that is solved by use of the claimed instrumentalities.


It is well settled that to "establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." MPEP §2143.03; *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974) ("All words in a claim must be considered in judging the patentability of that claim against the prior art."). Applicant respectfully submits that this has not been done in the present rejection because Kahle is completely silent as to use of the claimed pestle and base. Kahle does not even recognize the problem that has been solved and provides no motivation to overcome the problem. It is apparent from the silence of Kahle '325 that the rejection is made with improper hindsight relying upon Applicants own specification as the sole source for both the motivation and use of the pestle and base structure that is claimed.

The Office asserts that Kahle inherently discloses statistical analysis in the manner of claim 9 and the use of a destructible label. We respectfully disagree because these things do not necessarily follow from what is disclosed, particularly in the passage relied upon by the Examiner in column 5 at lines 27-38.

Applicant's attorney respectfully solicits a Notice of Allowance in this application. The Commissioner is authorized to charge any additionally required fees to deposit account 12-600. Applicants' attorney urges Examiner Fridie to telephone if a conversation could expedite prosecution.

Respectfully submitted,

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